

**In The United States Patent and Trademark Office
On Appeal From The Examiner To The Board
of Patent Appeals and Interferences**

In re Application of: Greg E. McRae
Serial No.: 10/807,217
Filing Date: March 22, 2004
Group Art Unit: 3727
Confirmation No.: 3298
Examiner: Stephen J. Castellano
Title: UNDERGROUND TANK SHROUD ASSEMBLY

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Reply Brief

Appellant respectfully submits this Reply Brief under 37 C.F.R. § 41.41 in response to the Examiner's Answer electronically sent November 12, 2008.

Appellant filed an Appeal Brief on July 28, 2008 (and a Supplemental Appeal Brief on August 21, 2008) explaining clearly and in detail why the final rejections of Claims 1-12, 15-16, and 19-36 are improper and should be reversed by the Board. As explained in more detail below, the Examiner's final rejection of these claims cannot be properly maintained. Appellants respectfully request the Board of Patent Appeals and Interferences (the "Board") to reverse these final rejections and instruct the Examiner to issue a Notice of Allowance with respect to these claims. In response to the Examiner's Answer, Appellants respectfully submit herewith their brief in reply.

Argument

The Examiner's Answer ("*Examiner's Answer*") consists of substantially similar arguments to those presented in the Final Office Action, along with a section responding to Appellant's arguments presented in the Appeal Brief. To reduce the burden on the Board, Appellant specifically addresses only the section of the Examiner's Answer directed to Appellant's arguments in the Appeal Brief. The remaining portions of the Examiner's Answer have already been addressed in Appellant's Appeal Brief.

I. Claims 1-12, 15-16, 19-34 and 36 are allowable over the *Kewitz-Fuchs-Anderson* combination.

Group 1: Claims 1-3, 5-7, 9-12, 15, 20-26, 28-30, 32-34, and 36 are allowable over the *Kewitz-Fuchs-Anderson* combination.

Appellant maintains that the proposed *Kewitz-Fuchs-Anderson* is improper and cannot support an obviousness rejection. Appellant previously argued that it would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, *to even attempt* to incorporate the teachings of *Fuchs* into the teachings of *Kewitz*, because *Kewitz* and *Fuchs* teach different and mutually exclusive coupling elements. The Examiner, in his Answer, states that "this statement seems conclusionary and is not based on facts or a reasonable analysis." *Examiner's Answer*, pg. 8. Appellant respectfully disagrees.

When proposing a combination of references for an obviousness rejection, a reference "must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." M.P.E.P. § 2141.02 (VI). Whenever "the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art." M.P.E.P. § 2143.01 (II). As discussed below, the teachings of *Kewitz* and *Fuchs* do conflict and would not suggest the Examiner's proposed combination to one of ordinary skill in the art.

Figure 1 of *Kewitz* appears to show element 13 that secures element 12 to element 11 when element 12 is in a closed position. *Fuchs* discloses a cover device with two "rotation and fixation devices" that allow "the cover [to] be lifted up in a direction perpendicular to the frame, without being tilted with respect to the frame, and during lifting the fixation/rotation

devices become disengaged.” *Fuchs*, ¶ 0014. The pivot elements of *Fuchs* can not be engaged simultaneously, and the engagement can only occur when one end is rotated upward. *See Fuchs*, Claim 4; ¶ 0016; Fig. 3. The pivot elements only interlock when an end is rotated upward, and when *Fuchs* is in a closed position, neither pivot element is interlocked to provide a hinge coupling. *See Fuchs*, ¶ 0025; Fig. 1. In fact, *Fuchs* touts the benefit of these features over traditional hinges. *See Fuchs*, ¶ 0007, 0014. Therefore, *Kewitz* discloses a coupling that secures an element in a closed position, while *Fuchs* discloses pivot elements that do not secure an element in a closed position. Modifying *Kewitz* to include the “rotation and fixation devices” of *Fuchs* would change the principle of operation of *Kewitz* and cause *Kewitz* to be unsatisfactory for its intended purpose. Because of this conflict, there is no indication that *Fuchs* would suggest, to a person of ordinary skill in the art, the combination of any elements of *Fuchs* with *Kewitz*.

For at least these reasons, Appellant respectfully contends that the combination of *Kewitz*, *Fuchs*, and *Anderson* is improper and does not disclose, teach, or suggest the combination of limitations of Claim 1, and therefore respectfully requests that the rejection of Claim 1 be withdrawn.

Claims 2-3, 5-7, 9-12, 15, and 20-23 each depend, either directly or indirectly, from Claim 1 and incorporate all the limitations thereof. Therefore, Claims 2-3, 5-7, 9-12, 15, and 20-23 are each patentably distinguishable from the combination of *Kewitz*, *Fuchs*, and *Anderson* for at least reasons analogous to those discussed above with regard to Claim 1.

Claim 24 includes limitations generally directed to a shroud lid configured to cover the top region of the shroud, the shroud lid coupled to the shroud at both a first hinge coupling and a second hinge coupling, when the shroud lid is in a closed position. Accordingly, Appellant contends that Claim 24 is patentably distinguishable from the combination of *Kewitz*, *Fuchs*, and *Anderson* for at least reasons analogous to those discussed above with regard to Claim 1.

Claims 25-26, 28-30, 32-34 and 36 each depend, either directly or indirectly, from Claim 24 and incorporate all the limitations thereof. Therefore, Claims 25-26, 28-30, 32-34 and 36 are each patentably distinguishable from the combination of *Kewitz*, *Fuchs*, and *Anderson* for at least reasons analogous to those discussed above with regard to Claims 1 and 24.

Group 2: Claims 4, 16, and 27 are allowable over the *Kewitz-Fuchs-Anderson* combination.

Appellant maintains that the proposed *Kewitz-Fuchs-Anderson* is improper and cannot support an obviousness rejection. Appellant previously argued that because *Fuchs* teaches away from the use of hinges, there is no indication that *Fuchs* would suggest, to a person of ordinary skill in the art, to modify the hinges of *Kewitz* in any way. The Examiner, in his Answer, states that “this is completely wrong.” *Examiner’s Answer*, pg. 9. Appellant respectfully disagrees.

While *Fuchs* does discuss the use of hinges with channel devices, it clearly discusses multiple “disadvantage[s] associated with the use of hinges.” *Fuchs*, ¶ 0007. This is not just a disadvantage of channel devices, as the Examiner contends, but also disadvantages with the use of hinges themselves. Appellant respectfully contends that, when “considered in its entirety, i.e., as a whole,” these discussed disadvantages “would lead away from the claimed invention.” M.P.E.P. § 2141.02 (VI).

Furthermore, Appellant respectfully contends that the Examiner’s attempt to extract a nut and bolt connection from *Anderson* is improper. Figure 1 of *Kewitz* appears to show element 13 that secures element 12 to element 11 when element 12 is in a closed position. The Examiner appears to support this position, stating that “the modified Kewitz-Fuchs assembly has two hinge assemblies that are fixedly coupled and not detachable or capable of decoupling.” *Examiner’s Answer*, pg. 5 (emphasis added). Instead, the Examiner relies solely on *Anderson* as disclosing a hinge that is detachable or decouples. *Examiner’s Answer*, pg. 5. Although the Examiner later contradicts himself, stating that *Kewitz* “may include only a pin that slidably couples within pin holes on each of the lid and shroud which is easy to remove,” he provides no basis for where this slidably coupling pin is disclosed in *Kewitz*. *Examiner’s Answer*, pg. 6. Therefore, Appellant maintains that there is no indication that the invention of *Kewitz* needs to be modified to provide a “more secure lid assembly,” as suggested by the Examiner. For at least these reasons, Appellant respectfully contends that the proposed *Kewitz-Fuchs-Anderson* combination is improper and cannot support an obviousness rejection.

Group 3: Claims 8, 19, 31 are allowable over the *Kewitz-Fuchs-Anderson* combination.

Appellant maintains that the proposed *Kewitz-Fuchs-Anderson* is improper and cannot support an obviousness rejection. Additionally, Appellant maintains that the proposed *Kewitz-Fuchs-Anderson* fails to disclose, teach, or suggest an underground tank shroud assembly, wherein the shroud comprises a generally conical shape. The Examiner, in his Answer, states that:

Fuchs teaches a conical shaped shroud as shown in Fig. 1 and 2 at the portion where the leader line for element 10 touches the frame, the frame is tapered in this location. A circular cover and circular frame configuration with a taper would result in a conical shape to the frame in this location. The frame of Fuchs is comparable to the shroud of the invention. It would have been obvious to modify the shroud to be conical to widen the top opening of the shroud to provide easier access and more space at the top opening. *Examiner's Answer*, pg. 6.

Appellant respectfully maintains that this portion of *Fuchs* fails to disclose, teach, or suggest a shroud comprising a generally conical shape. The frame 10 of *Fuchs*, as illustrated in Figure 1, has various bends, including several right angles. Appellant respectfully maintains that the intricate frame illustrated in Figure 1 would not disclose, teach, or suggest to one of ordinary skill in the art a shroud comprising a “generally conical shape.” Neither *Kewitz* nor *Anderson* cure this deficiency. Accordingly, Appellant respectfully contends that Claims 8, 19, and 31 are patentably distinguishable from the references cited by the Examiner.

II. Claim 35 is allowable over the *Kewitz-Fuchs-Anderson-Palazzo* combination.

Group 1: Claim 35 is allowable over the *Kewitz-Fuchs-Anderson-Palazzo* combination.

Claim 35 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Kewitz* in view of *Fuchs* and *Anderson* as applied to claim 24 and further in view of U.S. Patent No. 6,024,243 to Palazzo (“*Palazzo*”). Claim 35 depends from Claim 24 and incorporates all the limitations thereof. In rejecting Claim 35, the Final Office Action relies on the combination of *Kewitz*, *Fuchs*, and *Anderson* as disclosing each of the limitations of Claim 24. As

previously argued by Appellant and as discussed above, the combination of *Kewitz*, *Fuchs*, and *Anderson* is improper and does not disclose, teach, or suggest each of the limitations of Claim 24. *Palazzo* does not cure this deficiency. Therefore, Appellant submits that Claim 35 is allowable for at least reasons analogous to those discussed above with regard to Claims 1 and 24.

Conclusion

Appellant has demonstrated that the present invention, as claimed, is clearly patentably distinguishable over the references cited by the Examiner. Therefore, Appellant respectfully requests the Board to reverse the final rejection of the Examiner and instruct the Examiner to issue a Notice of Allowance of all pending claims.

Although Appellant believes no fees are due at this time, the Commissioner is hereby authorized to charge any necessary fees and credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Appellant

A handwritten signature in black ink, appearing to be 'L. K. Pedersen', written over a horizontal line.

Luke K. Pedersen
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Date: 1-12-09

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